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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,832	01/24/2002	Curtis A. Whitcomb	12459-0002	3414

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EXAMINER
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RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,832

Applicant(s)

WHITCOMB, CURTIS A.

Examiner

Dennis Ruhl

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/29/02; 4/26/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-7,9-12,14-22,24-32,49, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

Claims 1-7,9-12,14-22,24-32,49, do not recite or require the use of any technology to perform the recited steps. All of the recited steps could be performed by a person verbally receiving an order for a replica and manually executing the recited steps. The claims are directed to non-statutory subject matter because they are not within the technological arts.

3. Claims 33-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are considered to be reciting non-statutory subject matter because the claims are reciting a merchant (which can be a person) and a manufacturer (a person or persons). The claims include a person in the scope of the invention which is improper. People or persons are not allowed to be the subject of article claims. The examiner suggests reciting the merchant just in terms of what the merchant's system is made up of structurally (i.e. a merchant computer system). The claims are directed to non-statutory subject matter because the claims include people in its scope.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21,37-47, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 21, the examiner considers the recitation of "a state issued document" to be indefinite. It is now known what the scope of this term is because any document from the state could be considered a state issued document and this is not a definite thing. A state issued document can be many things and because of this the scope is not known. One wishing to avoid infringement would not know what constitutes a state issued document and what does not.

For claim 37, the functional language of this claim contradicts the functional language of claim 33. Does the information go from the merchant to the registrar as is claimed in claim 37, or does it go from the merchant to the manufacturer as is claimed in claim 33?

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,2,4-7,9,10,12,14-16,20-22,29,31,32, are rejected under 35 U.S.C. 102(a) as being anticipated by The Fernwood Company, "Sweating the details.." article, (6/11/2000).

For claims 1,2,4, Fernwood discloses the claimed method. Fernwood discloses that they are a company that makes replicas of buildings/landmarks for interested customers. It is disclosed that the Bangor Bank (a purchaser) asked Fernwood (the merchant) to make replicas of homes newly sold to bank customers. Inherently the bank must provide Fernwood with information on what they desire to be made in terms of what kind of house, color of house, etc.. The replica is disclosed as being given to the purchaser of the home by the bank.

For claim 5, the claimed registrar is considered to be an employee of the Fernwood Company. Somebody at the company receives information on the product and this person is the claimed registrar.

For claim 6, the information of what the replica is to look like is considered by the examiner to be information related to an owner of the product because the owner has purchased a house that looks like the replica. Fernwood satisfies what is claimed.

For claim 7, the claimed association of the product/replica to the owner is considered to be the making of a receipt for the purchased item. The examiner considers a receipt to be inherent that a receipt of some kind will be created. This can be an internal receipt (work order) or a receipt given to the purchaser of the replica.

For claim 9, the bank is the purchaser of the replica and is temporarily the owner of the replica until a point in time when the replica is given to the bank customer.

For claim 10, the examiner considers a name to be inherent information that is gathered concerning a given transaction.

For claims 12,20, the replica manufacturer is considered to be one of the employees that assists in the making of the replicas.

For claim 14, the examiner considers it inherent that the replica order will include product information (what are you buying?) and some type of owner information (who is paying for the item?).

For claim 15, the claimed identifier is considered to be text of the order. The word "blue" may be used to describe the color of the replica.

For claims 16,22,29, a certificate of ownership is considered to be a receipt showing proof of purchase. Because the Bangor bank is a professional financial type of company, they would necessarily retain receipts for their business expenses.

For claim 21, because a state document can reasonably take on any form and have any appearance, any receipt (cert. of ownership) is considered to "resemble" a state-issued document. To resemble may be interpreted to mean both are 8.5 X 11 inch pieces of paper. The resemble each other in size.

For claims 31,32, the Fernwood Company giving the replica to the bank and then the bank giving the replica to the home purchaser satisfies what is claimed. The registrar (a Fernwood employee) can give the replica to the bank (the owner at the present time).

8. Claims 1,3, are rejected under 35 U.S.C. 102b as being anticipated by "Hot Wheels" by Mattel.

For claims 1,3, when introduced in 1968, Mattel received product information about what kinds of cars they would like manufacture for their line of kids cars. The information is considered to be received because somebody in the company originally came up with the idea of "Hot Wheels" and then others were made aware of the idea. They then caused replicas to be made. Over the years Hot Wheels has made replicas of cars/trucks sold to consumers in the United States. This reads on what is claimed.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3,8,11,13,17-19,23-28,30,33-48, are rejected under 35 U.S.C. 103(a) as being unpatentable over The Fernwood Company, "Sweating the details.." article, (6/11/2000).

For claim 3, Fernwood does not disclose that the replica product is a vehicle. Fernwood only discloses the making of replica buildings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Fernwood manufacture replicas of vehicles for purchase by customers. Fernwood makes replicas of important landmarks and places of special importance to a purchaser. Many people treasure vehicles and the minor difference of making a replica vehicle as opposed to a replica of a building is considered to be obvious to one of ordinary skill in the art. Modifying the business of Fernwood by making vehicles instead of buildings does not result in a patentable invention as has been set forth by the examiner.

For claims 8,13,23, Fernwood does not disclose that the registrar receives product information from the merchant (from one computing device to another, registrar having a computer with database). Because the examiner has set forth that the registrar is considered to be an employee of Fernwood, the examiner considers the claimed system be 2 networked computers in one office (that are commonly used in small business situations). It would have been obvious to one of ordinary skill in the art at the time the invention was made to equip Fernwood with 2 computers networked together. It is well known and old in the art to utilize computers in the managing and



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execution of a business. Having two computers is a duplication of parts and provides flexibility and steady access to a computer when needed. With respect to the transfer of information from one computer to another, the examiner considers this to be the sharing of information in the business.

For claim 11, not disclosed is the use of numbers as claimed. It would have been obvious to one of ordinary skill in the art to use an invoice number or an order number (some number that represents the transaction) for purposes of accounting and record keeping. The claim reads on any number used to identify a particular product/transaction.

For claims 17,18, not disclosed is who creates the certificate of ownership (a receipt). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the manufacturer (the person that assisted in making the replica) or to have the registrar make the receipt. In small businesses, it is very common for employees to do more than one job and having any employee of Fernwood create the receipt would have been obvious to one of ordinary skill in the art. Somebody has to make the receipt, who actually makes it is irrelevant.

For claims 19,24,26, not disclosed is the giving of the replica and receipt to the registrar. It would have been obvious to one of ordinary skill in the art to have an employee of Fernwood take the mail out for pick up or to the post office itself. This results in the package to be mailed that includes the replica and a receipt being taken by the registrar (for mailing).

For claim 25, the examiner considers this to be the taking of a finished replica from an area where finished replicas are kept (a table, a shelf, etc.).

For claim 27, the claimed identification number is considered to be a house number on the replica. Since the company makes customer replicas of houses, and each house has a unique address, it would have been obvious to one of ordinary skill in the art at the time the invention was made to put the house number on the house. This way the customer can really feel like the replica is a replica because it even has the same house number. For example, 5567 Happiness Lane for the customer that just bought 5567 Happiness Lane.

For claim 28, the replica ID number (house number) has a characteristic in common with the product number. They are both numbers and this is the characteristic they have in common. Both are numbers.

For claim 30, the claimed "a merchant of the product" appears to be a new recitation of another merchant and is considered by the examiner to be the postal service that completed replicas can be mailed by. The registrar can take replicas to the post office (a merchant) to mailing to the owner.

For claims 33-35, Fernwood discloses the claimed system. The merchant is considered to be the bank. The examiner considers it inherent that banks have a computing device as claimed. The replica manufacturer is the Fernwood Company. The network is considered to be the "Internet" which was known as of the filing date of the instant application. The article discloses that the company intends to have a web page up and running soon. Not disclosed is that the Fernwood company has a

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computing device. The examiner considers that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Fernwood with a computing device (a computer) to assist in the running of the business and for Internet access. The use of computers in a small business such as the Fernwood Company is considered obvious and the use of the Internet (even just to receive email) is considered obvious. The recited method of using the system is given patentable weight to the extent that the prior art must be capable of operating as claimed, which in this case it does. The system is capable of operating as claimed.

For claims 36,39, because of the fact that the claims are article claims, the type of information on the order is considered to be non-functional descriptive material and does not serve to distinguish over the prior art. Even when given patentable weight, the order would inherently have information about the product and about the purchaser (or owner).

For claims 37,38, the claimed registrar is considered to be an employee at the bank that actually places the order with the Fernwood Company. The system is capable of operating as claimed.

For claims 40-48, the claims are directed to the method of using the claimed system which is the intended use of the system; however in article claims the manner of use is not given much patentable weight. The manner of use has been given patentable weight to the extent that the system of Fernwood is fully capable of being used as claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER